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Mailed:
August 31, 2005
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Boomerang.com, Inc.,

v.

Market Tools, Inc.

Opposition No. 91150250
against Serial Nos. 75821186 and 75821187

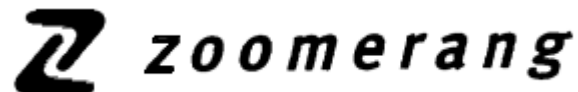
Anthony J. Malutta, Elizabeth R. Gosse and John A. Hughes
of Townsend and Townsend and Crew LLP for Boomerang.com,
Inc.

Sheila Fox Morrison and Thomas R. Burke of Davis Wright
Tremaine LLP for Market Tools, Inc.

Before Quinn, Bucher and Kuhlke, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Market Tools, Inc. seeks registration on the Principal
Register of the mark **ZOOMERANG** (standard character
drawing)¹ and the following special form drawing:



¹ Application Serial No. 75821187 was filed on October 13, 1999 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

both marks to be used in connection with services recited as amended, as

"building and facilitating of market research communities; dissemination of information in the fields of advertising, marketing, and business via electronic mail; providing information and technical consultation in the field of survey research methods, real-time feedback, and results; providing information in the field of market research" in International Class 35; and,

"providing temporary use of non-downloadable computer software for designing and conducting surveys, polls and other feedback and data collection activities via computer and communication networks; providing temporary use of non-downloadable computer software for the administration, distribution, collection, reporting, analysis and presentation of information gathered via computer and communication networks; hosting web-based surveys, polls and other feedback and data collection instruments for others; acquisition of potential survey respondents and their data for others" in International Class 42.²

Registration has been opposed by Boomerang.com, Inc. As its ground for opposition, opposer asserts that applicant's marks when used in connection with applicant's services so resemble opposer's previously used and registered marks, as to be likely to cause confusion, to cause mistake or to deceive under Section 2(d) of the Lanham Act.

² Application Serial No. 75821186 was filed on October 13, 1999 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

Applicant, in its answer, has denied the salient allegations in the opposition.

The Record

By operation of the rules, the record includes the pleadings and the files of the opposed applications. Opposer has also made of record its pleaded registrations by submitting certified status and title copies of the following registrations:

REGISTRATION No. 1731670 **BOOMERANG** (STANDARD CHARACTER DRAWING)
for "automated facsimile retrieval and transmission services" in
International Class 38;³

REGISTRATION No. 2233267 **BOOMERANG INFORMATION SERVICES**
for "services for sending and retrieving data, namely, the
electronic transmission and reception of data via the
global computer information network" in International Class
38.⁴

Opposer, as part of its case-in-chief, has also made of record, pursuant to a notice of reliance, the testimonial deposition of David A. Kearney, President and Chief Executive Officer of Boomerang.com, Inc., and exhibits thereto, applicant's responses to opposer's First Set of Interrogatories and documents related thereto, and

³ Registration No. 1731670 issued on November 10, 1992, claiming first use anywhere at least as early as August 1991 and first use in commerce at least as early as October 1991; renewed

⁴ Registration No. 2233267 issued on March 23, 1999, claiming use anywhere and use in commerce at least as early as September 1994. The words "Information Services" are disclaimed apart from the mark as shown.

applicant's responses to opposer's First Set of Requests for Admission and documents related thereto. Applicant's case-in-chief consists of the testimony, with exhibits, of Dana Meade, Vice President and General Manager of Market Tools, Inc., a dictionary definition of the word "boomerang" and the letter "Z" section of the dictionary, both from *Oxford Dictionary & Thesaurus* (Am. Ed. 1996), and copies of forty-four electronic (TESS) records from the United States Patent and Trademark Office (USPTO) of third-party registrations containing the term BOOMERANG, all submitted by applicant via its notice of reliance. The parties have fully briefed the case, but an oral hearing was not requested.

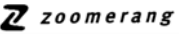
Accordingly, the issues to be determined in this proceeding are whether opposer has priority of use of its BOOMERANG marks for a range of marketing communication services, including telephone and email survey services, and, if so, whether contemporaneous use by applicant of its ZOOMERANG marks in connection with its marketing services and online survey services is likely to cause confusion, to cause mistake, or to deceive.

Standing

As noted above, opposer has made of record status and title copies of its pleaded registrations. In view thereof, and because opposer's likelihood of confusion claim based thereon is not frivolous, we find that opposer has standing to oppose registration of applicant's marks. See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Facts

The Opposer specializes in large-scale marketing campaigns for Fortune 1000 companies in retail, financial services, travel services, entertainment-related services, as well as those in the software, hardware, high-tech and publishing industries. As suggested by its first BOOMERANG registration (for "automated facsimile retrieval and transmission services"), the testimony evidence shows that opposer initially conducted direct marketing services by facsimile services and other telephone-based methodologies. With the changed technologies of the Internet age, opposer shifted to email marketing services (Kearney testimony, pp. 8-16, and Ex. 2), and as suggested by the wording of its second claimed registration [Registration No. 2233267].

Applicant, MarketTools, Inc., provides market research services for companies and not-for-profit organizations, and also offers a software tool online by which the user can create and send market research surveys without the need for assistance or interaction with applicant. This do-it-yourself service gives users access to tools and resources to help develop survey questionnaires, send those surveys to potential respondents, then view and analyze the results and respondent comments. Applicant adopted the trademark ZOOMERANG for use in connection with its online market research survey services, and filed the two involved trademark applications [ZOOMERANG and  on October 13, 1999.

It is clear that applicant is a marketing research survey company, with its business research services correctly classified in International Class 35, and its computer services as an application service provider (ASP), and its providing for the temporary use of non-downloadable computer software, in International Class 42.

According to the testimony of opposer's president, surveys make up 10 to 15% of opposer's email marketing services business at the present time. From opposer's most recent web pages that have been made of record, it is clear that this portion of opposer's services is directly

competitive with applicant's services, namely, as an ASP offering marketing research survey services. Applicant agrees that with the expansion of opposer's services in recent years, opposer's services might well now include the distribution and collection of surveys. The determinative issue in this case is whether this expansion took place prior to October 13, 1999.

PRIORITY

Priority based on Registrations

Inasmuch as opposer's pleaded registrations are not the subject of counterclaims or separate petitions to cancel by applicant, priority under Section 2(d) is not an issue in this case, as to the services recited in the registrations. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

The involved applications are intent-to-use applications filed on October 13, 1999. Applicant's witness has also testified that applicant's ZOOMERANG website was launched on November 1999. Meade testimony, pp. 17 - 18. Certainly, applicant has not tried to establish a date of first use in commerce earlier than the constructive date of first use established by its applications' filing date. Accordingly, applicant does not

argue that it has an earlier date of first use than
opposer's recited services in International Class 38.

Priority based upon opposer's common law rights

In the event that opposer has not established that the
services recited in the registrations are related to
applicant's recited services, applicant argues correctly
that in order for opposer to establish priority of use, it
has the burden of proving that as of October 13, 1999, it
had valid common law rights in the mark for marketing
research survey services. On the critical issue of whether
opposer has demonstrated that it can rely upon prior common
law rights in its BOOMERANG mark extending to telephone and
email survey services, the parties strongly disagree.

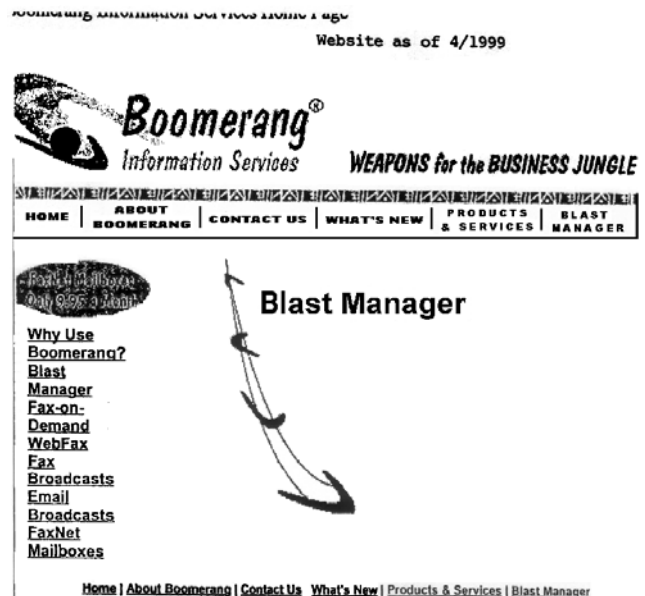
Eastman Kodak Co. v. Bell & Howell Document Mgmt. Products
Co., 994 F.2d 1569, 1575, 26 USPQ2d 1912, 1918 (Fed. Cir.
1993) ["[T]he challenger's burden of proof in both
opposition and cancellation proceedings is a preponderance
of the evidence."].

Mr. Kearney, the founder of opposer, is a software
engineer with training and experience in marketing. At its
inception in 1991, opposer was providing its customers with
fax-on-demand, fax broadcasts and interactive voice
response connections via Touch-Tone telephones as ways of

communicating with its customers' customers. Over the next several years, opposer initiated telephone surveys and quizzes as well as faxed survey questions where the returned forms were scanned using optical character recognition (OCR) technologies. Around 1995, as opposer moved into the Internet world, it started utilizing email services, including automated surveys. Even though the record does not contain documentary support for opposer's offering this type of service, we find Mr. Kearney's testimony on this point to be uncontroverted. That is, while opposer has failed to supply definitive evidence in support of this testimony, we find, despite applicant's claims to the contrary, that this oral testimony is in no way inconsistent with applicant's documentary evidence on this point. Furthermore, we find it a logical progression for opposer's marketing services to have switched from providing direct mail, fax and telephone surveys in 1991-1992 into providing email surveys by 1995-1996 -- soon after establishing an online presence in 1994. Kearney testimony, pp. 8, 13, 27 - 37.

Applicant points out that in late-1999, before adopting the ZOOMERANG mark, applicant conducted various searches, discovering, *inter alia*, opposer's fax and Internet services being offered under the BOOMERANG mark.

However, applicant argues that none of the products or services then shown on opposer's website were described as survey tools or services. In cross-examining Mr. Kearney, applicant's counsel used an archived copy of opposer's website as it existed during April 1999. It appears as if there were a series of vertical buttons on the left side of the home page, as well as larger, horizontally-placed buttons across the top of the page. During its cross examination of Mr. Kearney, applicant's counsel appears to have used the web pages that follow from the left hand buttons, such as "Why Use Boomerang?," "Blast Manager," "Fax-on-Demand," "WebFax," "Fax Broadcasts," "Email Broadcasts," and "FaxNet Mailboxes." However, it does not appear as if applicant submitted any of the web pages that follow from the buttons across the top, such as "Products and Services." Kearney testimony, pp. 39 - 40, Exhibit 5.



Accordingly, we find that Exhibit 5, in its totality, does not contradict Mr. Kearney's testimony. As opposed to

providing inconsistent information, we find it significant that web pages dealing with opposer's "Products and Services" are simply missing from applicant's submission for the record.⁵ We acknowledge that opposer appears to have failed to highlight this function during the 1996 to 1999 time frame in the "*Why Use Boomerang?*" section of its website, for example, and that opposer failed to submit for the record any direct mail marketing materials, letters or other documentary evidence rebutting this seeming absence of a key, claimed service from the archival screen prints of its website from 1999. Nonetheless, we find that opposer has established by a preponderance of the evidence that it was providing survey-related services at the time the applicant applied for and began using its ZOOMERANG mark and thus established its priority as to these services. Sealy, Inc. v. Simmons Co., 265 F.2d 934, 121 USPQ 456, 458 (CCPA 1959) ["[A]lthough prior use must be established by a preponderance of the evidence ... such use can be proven by the testimony of only one witness."]


⁵ We note that applicant did choose to introduce into the record the "Products and Services" summary from a re-designed webpage of a year later (2000), which given the absence of any listing of surveys in that summary page, evidently supported applicant's position herein. Kearney testimony, Exhibit 6.

Likelihood of Confusion

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the services and/or goods. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We turn first to the du Pont factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services and/or

goods offered under the respective marks is likely to result.

Applicant's ZOOMERANG marks are quite similar to opposer's BOOMERANG mark, as previously used and registered, as to sound and appearance. Applicant's marks simply replace the letter "B" with a rhyming letter "Z." While the modification of the initial letter does create a somewhat different appearance, the change of a single letter in the applicant's mark does not change the look of the mark significantly. In the context of applicant's business and marketing survey services, the coined word "zoomerang" clearly evokes the word "boomerang." Both suggest the delivery of some form of communications that anticipates a response. The parties agree that applicant's melding of the word "zoom" into the first syllable of the word "boomerang" suggests that applicant's services allow for a quick return. However, we agree with opposer that this additional meaning does not change significantly the commercial impression of applicant's marks. Certainly considering applicant's mark preceded by a design feature,  *zoomerang*, the fact that the fanciful letter "Z" is made up of two boomerangs simply reinforces the impression of the "boomerang" origin of the "zoomerang" mark. As seen above, it is also reminiscent of opposer's website trade dress.

In summary, on this du Pont factor, a proper evaluation of the marks in their entirety show that they are highly similar as to commercial impression, and that the minor differences one might discover with a side-by-side comparison certainly do not outweigh these similarities. Hence, we find that this du Pont factor favors opposer.

We turn next to the du Pont factor focusing on the relationship of the respective services. As to the telecommunications services recited in opposer's registrations, there is no evidence in the record showing that these telecommunication services are related to applicant's recited services, nor is there any evidence to suggest that online marketing research survey services would be within the "natural zone of expansion" for such a service provider. Thus, we find that opposer has not established a relationship between the services recited in opposer's registrations and the subject applications. As discussed earlier, we have found that applicant and opposer both function as application service providers offering online their automated marketing research survey services. While the exact nature of their online or email survey services may be slightly different, their automated survey services represent competitive options for prospective

customers. Hence, we find that this du Pont factor too favors opposer, at least as to business survey services.

In a related du Pont factor focusing on the similarity of established, likely-to-continue trade channels, according to the evidence of record, both parties are currently using the Internet in order to provide a way for customers to use their services and to promote their respective services to prospective customers. Accordingly, we find that the channels of trade are identical.

As to the conditions under which and buyers to whom sales are made, applicant permits individuals interested in conducting a very basic survey to do so free of charge. This means its customer base will not necessarily be restricted to sophisticated users. By contrast, because opposer tends to cater mostly to larger, Fortune 1000 companies, the classes of persons making these purchasing decisions would constitute sophisticated and discriminating purchasers. Nonetheless, we also agree with opposer that the ultimate consumers of both parties' survey services include many members of the general public who receive the survey queries. Hence, we disagree with applicant's position that the ultimate recipients of applicant's and opposer's survey invitations are not consumers of these services, and are irrelevant to the likelihood of confusion

analysis. Although these ultimate consumers may not directly purchase services from applicant or from opposer, they would be aware that they have been contacted by a marketing survey company trading under a specific trade name and having a return email address. Such consumers plainly are akin to ordinary consumers and would not, therefore, be expected to exercise a great deal of care or deliberation in how they may deal, for example, with any unhappiness over receiving such an invitation. Giving consideration to likely confusion on the part of such ordinary consumers means that this du Pont factor too would weigh slightly in favor of a finding of a likelihood of confusion herein.

We turn then to the du Pont factor focusing on the nature and extent of any actual confusion. Upon reviewing the entire record, we agree with applicant that opposer's characterization of actual confusion is "dramatically oversold." The documentary evidence consists of six misdirected opt-out email messages from recipients of survey invitations over an eight-month period (September 2001 to April 2002). If indeed applicant sends out more than twenty million survey invitations a year and opposer sends out more than 300 million automated messages a year, we are not convinced that six misdirected email messages

comprises a strong case for actual confusion. If each one of tens (or even hundreds) of millions of potential opt-out recipient of a survey invitation had to actually type in the "abuse@zoomerang.com" email address, inevitably some individuals would type a letter "b" (for the familiar word "boomerang") instead of a letter "z" at the beginning of the originator's domain name *qua* email address. In this context, we find that these six emails were likely the result of inattentive typing rather than the result of a perceived connection between applicant and opposer. See Therma-Scan, Inc. v. Thermoscan, Inc., 295 F.3d 623, 636, 63 USPQ2d 1659 (6th Cir. 2002). Hence, we find that this evidence must be viewed as *de minimis* and accorded very little probative value. McGraw-Hill Publ'g. Co., Inc. v. Am. Aviation Assocs., 117 F.2d 293, 295, 47 USPQ 494 (App. D.C. 1940).

Additionally, while Mr. Kearny describes the telephone calls, emails, and other forms of confusion between opposer and applicant as representing a pervasive and ongoing problem for opposer, his testimony in this regard was not very specific and other than the aforementioned six misdirected emails, the record contains absolutely no corroborating evidence (e.g., no "customer care" call

records, no affidavits from www.boomerang.com personnel, etc.) of this alleged pattern of actual confusion.

Conversely, as to the factor focusing on length of time during which there has been concurrent use without evidence of actual confusion, applicant argues that it should be found to favor applicant. Even though we deem the six examples of record to be *de minimis*, we do not agree that these marks "have been simultaneously used for five years without causing any consumers to be confused."

In light of the *de minimis* nature of the e-mail evidence and the nonspecific testimony lacking any supporting documentary evidence, we find opposer's alleged evidence of actual confusion as well as applicant's alleged absence of actual confusion to be neutral factors herein.

As to the renown of opposer's BOOMERANG mark, the record does not contain evidence as to opposer's sales figures or the level of opposer's marketing expenditures. While the mark appears to be inherently distinctive for these services, the record is largely devoid of any evidence of how much exposure consumers had to the BOOMERANG mark used in connection with marketing surveys in the period since 1995. Hence, we find on this record, that opposer has not established that its mark is well known for marketing surveys, making this another neutral factor.

As to the du Pont factor focusing on the variety of services and/or goods on which a mark is or is not used, opposer argues that it uses its BOOMERANG mark on a variety of marketing and communications services. Yet as noted earlier, its registrations of record do little to support this position. While we find Mr. Kearney's testimony sufficient to establish priority as to online survey services, the evidentiary support for finding that opposer should be given a broad and exclusive scope of rights in the BOOMERANG mark for a wide range of marketing communications services is missing from this record. Hence, this too is a neutral factor.

We turn next to the du Pont factor focusing on the number and nature of similar marks in use on services similar to opposer's claimed services. Applicant takes the position that opposer's BOOMERANG mark is weak because it appears to be one in a crowd of BOOMERANG marks. By notice of reliance, applicant has demonstrated that opposer's BOOMERANG marks "are two out of 44 active trademark registrations that include the term BOOMERANG." These third-party BOOMERANG trademark registrations include the following, as highlighted by applicant in its brief:

REGISTRATION No. 2390924 **BOOMERANG**

(standard character drawing)

for "providing business and advertising information regarding the compilation and evaluation of data related to global computer network web sites and users; dissemination of advertising in the nature of delivery of online advertising banners; conducting marketing studies in the nature of providing targeting and reporting services related to the dissemination of advertising on the global computer network" in Class 35⁶

REGISTRATION No. 2712550 **BOOMERANG WIRELESS**

(standard character drawing)

for "wireless telecommunication services, namely the transmission of voice by electronic means" in Class 38⁷

REGISTRATION No. 2787976 **BOOMERANG POWERED BY ALLTEL**

(standard character drawing)

for "wireless telecommunication services, namely the transmission of voice by electronic means" in Class 38⁸

⁶ Registration No. 2390924 issued to DoubleClick, Inc. on October 3, 2000, reciting a date of first use in commerce at least as early as August 18, 1998.

⁷ Registration No. 2712550 issued to AllTell Communications, Inc., on May 6, 2003, reciting a date of first use in commerce at least as early as October 15, 2000.

⁸ Registration No. 2787976 issued to AllTell Communications, Inc., on December 2, 2003, reciting a date of first use in commerce at least as early as May 25, 2001.

REGISTRATION No. 2610075 **BOOMERANG**

(standard character drawing)

for "cable television broadcasting services;
broadcasting programs directed to children and
young adults via global computer network" in Class
38⁹

Arguably DoubleClick Inc.'s services, recited above as " ... dissemination of advertising in the nature of delivery of online advertising ... ," are related to opposer's usage in connection with the marketing services that Mr. Kearney discussed in his testimony. However, opposer argues that there is "no evidence of record that other parties use or have used BOOMERANG for marketing communications services generally or telephone or email survey services specifically." Opposer correctly argues that inasmuch as there is no evidence that any of these forty-two third-party registrations are for marks that are actually in use, the probative value of these registrations is most limited. It is well settled that third-party registrations are not evidence of what happens in the marketplace or that the public is familiar with the use of the subject marks. See National Aeronautics & Space Administration v. Record Chemical Co., 185 USPQ 563, 567 (TTAB 1975). Clearly,

⁹ Registration No. 2610075 issued to The Cartoon Network, LLP, on August 20, 2002, reciting a date of first use in commerce at least as early as April 1, 2001.

third-party registrations do not show that the marks which are the subjects thereof are actually being used, or that the extent of their use is so great that customers have become accustomed to seeing the marks and hence have learned to distinguish them. See Smith Brothers Manufacturing Co. v. Stone Manufacturing Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983). Consequently, the co-existence of the third-party registrations with opposer's pleaded registrations does not justify registration of a confusingly similar mark by applicant. AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973).

Accordingly, in view of the absence of any evidence demonstrating that the marks which are the subjects of the third-party registrations made of record by applicant are actually in use, this du Pont factor favors opposer, but because of the suggestive nature of the term for such services, it favors opposer only minimally.¹⁰

¹⁰ To the extent that these third-party registrations do show that the term "boomerang" has a normally understood and well-known meaning in the broad field of automated interactions, and hence may be somewhat suggestive of a key element of such services, Red Carpet Corp. v. Johnstown American Enterprises Inc., 7 USPQ2d 1404 (TTAB 1988), we have already found that opposer has not established that it is a well known mark or one meriting a broad scope of protection.

In conclusion, upon weighing all the relevant du Pont factors in this case, and giving each its appropriate weight, we find a likelihood of confusion herein. We find opposer is favored on two key considerations, i.e., that the parties' marks are similar in appearance, sound, connotation and commercial impression while the parties' respective survey services represent competitive options for prospective customers. On this record, we have found that opposer's prior mark has not been shown to be either weak or well known, and on balance, the few cases of misdirected email shown in the record help neither party.

Decision: The opposition is sustained on the ground of likelihood of confusion under Section 2(d) of the Lanham Act, and registration to applicant for both of the affected applications is hereby refused.